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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/500,118

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Henrik Semb

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EXAMINER

TON, THAIAN N

ART UNIT

PAPER NUMBER

1632

NOTIFICATION DATE

DELIVERY MODE

10/21/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

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|--|--|--|--|
| <p align="center"><b>Advisory Action</b><br/><b>Before the Filing of an Appeal Brief</b></p> | <p><b>Application No.</b><br/>10/500,118</p> | <p><b>Applicant(s)</b><br/>SEMB ET AL.</p> |  |
|  | <p><b>Examiner</b><br/>Thaian N. Ton</p>     | <p><b>Art Unit</b><br/>1632</p>            |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 24 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-5, 9-20, 35, 60-62, 64 and 65.  
Claim(s) withdrawn from consideration: 22-34 and 36-56.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 9  
13. ☐ Other: \_\_\_\_\_.

/Thaian N. Ton/  
Primary Examiner, Art Unit 1632

Continuation of 3. NOTE: The proposed claim amendments are not entered because they raise potential new issues of search and/or consideration with regard to the limitation that the isolation of the inner cell mass cells by mechanical dissection "does not comprise the use of immunosurgery."

Continuation of 11. does NOT place the application in condition for allowance because: MPEP 714.13 states that Applicants cannot, as a matter of right, amend any finally rejected claims, except when an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some way requires only cursory review by the examiner. The proposed claim amendments raise potential new issues under 35 U.S.C. 112, 1<sup>st</sup> paragraph, regarding new matter, as well as further search and consideration. Thus, this proposed amendment requires more than a "cursory review." Therefore, the present amendment will not be entered. Applicants' amendment rely upon proposed claim amendments which are not entered; therefore, all prior rejections of record are maintained. Claims 1-3, 5, 12, 13, 16-20, 62, 64, 65 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (2001) when taken with Thomson (1998) as evidenced by Stem Information (National Institutes of Health), when taken with Rijnders et al. and in further view of Lanzendorf et al. when taken with US Pat. No. 6,875,607 (published April 5, 2005; filed November 9, 1999).

Claims 4, 9, 10, 60 and 61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (2001) when taken with Thomson (1998) when taken with Rijnders et al., Lanzendorf et al. in further view of and US Pat. No. 6,875,607 (published April 5, 2005; filed November 9, 1999) as applied to claims 1-3, 5, 6, 12, 13, 16-20, 62, 64, 65 above, and further in view of Marshall et al. (Methods in Molecular Biology: Isolation and Maintenance of Primate Embryonic Stem Cells 158: 11-18, January 2001).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (2001) when taken with Thomson (1998) when taken with Rijnders et al., Lanzendorf et al. and in further view of US Pat. No. 6,875,607 (published April 5, 2005; filed November 9, 1999), as applied to claims 1-3, 5, 6, 12, 13, 16-20, 62, 64, 65 above, and further in view of Conner.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (2001) when taken with Thomson (1998) when taken Rijnders et al., Lanzendorf et al. and in further view of US Pat. No. 6,875,607 (published April 5, 2005; filed November 9, 1999), as applied to claims 1-3, 5, 6, 12, 13, 16-20, 62, 64, 65 above, and in further view of Gardner et al. (1998), when taken with Gardner (1999).

Claim 35 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Thomson (U.S. Pat. No., 6,200,806 B1, issued March 13, 2001, cited above) when taken with Stratagene Catalog, 1988, p. 39.